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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,068	02/19/2007	Wilfried Stubbe	PAT-01152	2133
26922	7590	10/01/2010	EXAMINER	
BASF CORPORATION			STREGE, JOHN B	
Patent Department				
1609 BIDDLE AVENUE			ART UNIT	
MAIN BUILDING			PAPER NUMBER	
WYANDOTTE, MI 48192			2624	
			NOTIFICATION DATE	DELIVERY MODE
			10/01/2010	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

MARJORIE.ELLIS@BASF.COM  
Mgolota@CantorColburn.com  
apeluyera@cantorcolburn.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/595,068	<b>Applicant(s)</b> STUBBE ET AL.	
	<b>Examiner</b> JOHN B. STREGE	<b>Art Unit</b> 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☒ Claim(s) 16-20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>01/30/06</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 7 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 recites the limitation "the automobile body or the test panel" in lines 5-6.

There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4,6-10,12, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Forslind, *Replication techniques for dry and wet biological surfaces* (cited in the IDS).

Regarding claim 1, Forslind discloses A method of characterizing surface structures (see the abstract) which comprises (I) using a chemically curable impression material to take an impression of at least one site (I 1) of the undamaged surface of an article (page 135, second column, fourth paragraph, plastic impression technique) and

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one of (I.2) a surface of an article damaged by at least one of mechanical exposure, chemical exposure, exposure to radiation and exposure to heat, and  
(I 3) a surface of a test specimen mounted on the surface of an article, said test specimen surface being damaged by at least one of mechanical exposure, chemical exposure, exposure to radiation and exposure to heat (the first paragraph on page 137 recites that multiple impressions may be made in order to remove loose surface material (or damaged surface material) and that the impressions can be checked against each other for artefacts) (II) curing the impression material to produce a negative of the damage pattern (page 135, second column, fourth paragraph, plastic impression technique), and (III) using image analysis to determine at least one of the extent (%) of the surface structures and/or the extent (%) of the surface damage within the damage pattern on the basis of light- microscope pictures of the negative (last section on page 138, combination with morphometric systems, image analysis systems or other physical measurement systems will allow quantitative analysis of changes in the surface structures as a result of the progress of a disease, the influence of environmental factors or, in medical applications, a treatment of a disease).

Regarding claim 2, a positive is produced from the negative (second paragraph of the second column of page 133).

Regarding claims 3-4, the extent of surface damage is determined by image analysis on the basis of light microscope pictures of the positive (last section on page 138).

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Regarding claim 6, silicone is used (second paragraph of the second column of page 133).

Regarding claim 7, the material is pressed onto the surface to form an impression (second paragraph of the second column of page 133).

Regarding claim 8, a positive is produced from the negative (second paragraph of the second column of page 133).

Regarding claim 9, the object is sputter coated with gold (paragraph 5 on the second column of page 135).

Regarding claims 10 and 12, a high resolution digital camera is used and two measurement fields are used (first column of page 135).

Regarding claim 14, image analysis is carried out (last paragraph of page 138).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5, 11, 13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forslind.

Regarding claim 5, as discussed above Forslind discloses the limitations of claim 1. Forslind does not explicitly disclose using a composition containing olefinically unsaturated double bonds is used as chemically curable impression material. However

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Forslind does disclose that any material that works well and does not affect the surface being tested can be used (second paragraph of the second column of page 133), thus it would be a matter of design choice to use a composition containing olefinically unsaturated double bonds since it would not affect the testing surface.

Regarding claims 11 and 13, the degree of magnification is a matter of design choice and would depend on the structure being analyzed thus it would be obvious to use different magnification factors depending on the underlying surface.

Regarding claim 15, it is well known to take color images of skin to analyze the images for different disease thus the examiner declares official notice that it would have been obvious to take color images of the surface to carry out skin analysis procedures.

#### ***Allowable Subject Matter***

7. Claims 16-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN B. STREGE whose telephone number is (571)272-7457. The examiner can normally be reached on Monday-Friday between the hours of 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta can be reached on (571) 272-7453. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John B Strege/  
Primary Examiner, Art Unit 2624